

REMARKS

Claims 16-37 and 39 are pending. Claims 1-15 and 38 were previously canceled. Reconsideration of the application is requested.

§ 102 and § 103 Rejections Based on Svigelj

Claims 27-29, 31, 35, and 37 stand rejected under 35 USC § 102(b) as being anticipated by, or in the alternative under 103(a) as obvious over, U.S. Patent No. 4,166,058 to Svigelj et al. ("Svigelj"). Applicant respectfully disagrees with the Examiner's rejection.

With regard to the rejection of these claims under 102(b), independent claim 27 recites "wherein the surface color is selected from a group consisting of gray and black." The Examiner admits that Svigelj does not describe this claim element but states that "although patentee does not indicate the color of the brake shoe, they are commonly black in color." For this reason alone, independent claim 27 and its dependent claims cannot be anticipated by Svigelj because, as the Examiner admits, Svigelj does not describe each and every element of independent claim 27. Further, independent claim 27 recites "irreversibly changing the color of the marker." Svigelj does not describe or suggest an irreversible color change. Additionally, independent claim 27 recites "wherein the second color is sufficient to effectively render the marker invisible." Svigelj does not describe the primer being rendered effectively invisible. Instead, Svigelj describes a color change from blue at room temperature to bright green to dark green to brown (col. 1, lines 44-49), and the Examiner states that steel is commonly black in color (Office Action, page 2). For at least these reasons, the rejection of claims 27-29, 31, 35, and 37 under 35 USC § 102(b) as being anticipated by Svigelj has been overcome and should be withdrawn.

With regard to the rejection of claims 27-29, 31, 35, and 37 under 103(a) based on Svigelj, the Examiner has failed to make a prima facie case of obviousness. For example, the Examiner does not provide any teaching, suggestion, or motivation to modify the primer of Svigelj so that it would effect an irreversible color change or so that the color change rendered the marker invisible. In fact, the Examiner states brake shoes are commonly black and Svigelj describes a color change from blue at room temperature to bright green to dark green to brown (col. 1, lines 44-49), so Svigelj teaches away from a color change that renders the marker invisible. The rejection of claims

27-29, 31, 35, and 37 under 35 USC § 103(a) as being unpatentable over Svigelj has been overcome and should be withdrawn.

§ 102 and § 103 Rejections Based on Edenbaum

Claims 27-29, 31, 35, and 37 stand rejected under 35 USC § 102(b) as being anticipated by U.S. Patent No. 3,386,807 to Edenbaum et al. ("Edenbaum"). Applicant respectfully disagrees with the Examiner's rejection.

Independent claim 27 recites "wherein the surface color is selected from a group consisting of gray and black." The Examiner admits that Edenbaum does not describe this claim element but states that "the use of black tapes would be an obvious design choice to an ordinary practitioner of the art." For this reason alone, independent claim 27 and its dependent claims cannot be anticipated by Edenbaum because, as the Examiner admits, Edenbaum does not describe each and every element of independent claim 27. Further, independent claim 27 recites "irreversibly changing the color of the marker." Edenbaum does not specifically describe or suggest an irreversible color change. Additionally, independent claim 27 recites "wherein the second color is sufficient to effectively render the marker invisible." Edenbaum does not describe the tape or ribbon or strip being rendered effectively invisible. Instead, Edenbaum teaches away from this claim element. Specifically, Edenbaum describes a color change from white or light yellow to green (col. 3, lines 22-24) and states that this "change in color is readily identified." This is in line with one of the stated goals of Edenbaum - to have a "strong contrasting color change" (col. 3, lines 3-4). For at least these reasons, the rejection of claims 27-29, 31, 35, and 37 under 35 USC § 102(b) as being anticipated by Edenbaum has been overcome and should be withdrawn.

The Examiner also stated that "the subject matter of claims 27-29 and 31-37 of the present application is obvious" by Edenbaum. With regard to any rejection of these claims under 103(a) based on Edenbaum, the Examiner has failed to make a prima facie case of obviousness. For example, the Examiner does not provide any teaching, suggestion, or motivation to modify the tape, ribbon, or strip of Edenbaum so that it would effect an irreversible color change or so that the color change rendered the tape, ribbon, or strip invisible. This is especially important since Edenbaum teaches away from a color change that renders the tape, marker, or strip invisible. The rejection of

claims 27-29, 31, 35, and 37 under 35 USC § 103(a) as being unpatentable over Edenbaum has been overcome and should be withdrawn.

§ 103 Rejections Based on Edenbaum in view of Radcliffe

Claims 16-37 and 39 are rejected under 35 USC § 103(a) as being unpatentable over Edenbaum in view of U.S. Patent No. 3,450,556 to Radcliffe ("Radcliffe"). Applicant respectfully disagrees with the Examiner's rejection.

The Examiner has failed to make a prima facie case of obviousness for failure to show a motivation to combine Edenbaum and Radcliffe. For example, Radcliffe specifically states that one of its goals was to find "a solution which operates well under ambient temperature conditions to effect color discharge of the pigment" (col. 2, lines 67-69). This teaches away from the use of a "thermal-sensitive pigment" as recited in independent claim 16 of the pending application and of the teachings of Edenbaum. Consequently, at the time of the invention, one of skill in the art would not have combined these two references.

The rejection of claims 16-37 and 39 under 35 USC § 103(a) as being unpatentable over Edenbaum in view of Radcliffe has been overcome and should be withdrawn.

Examination and reconsideration of the application is requested.

Respectfully submitted,

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